

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number

Q97138

Mail Stop AF
 Commissioner for Patents
 P.O. Box 1450 Alexandria, VA 22313-1450

Application Number

10/599,151

Filed

September 21, 2006

First Named Inventor

Masaki YANAGIOKA

Art Unit

1796

Examiner

John E USELDING

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

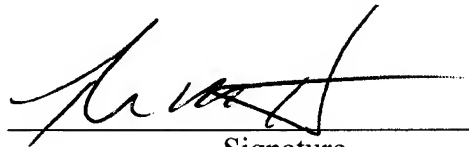
This request is being filed with a notice of appeal

The review is requested for the reasons(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

☒ I am an attorney or agent of record.

Registration number 64,676



Signature

Thomas M. Hunter

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June 30, 2010

Date

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q97138

Masaki YANAGIOKA, et al.

Appln. No.: 10/599,151

Group Art Unit: 1796

Confirmation No.: 5036

Examiner: John E USELDING

Filed: September 21, 2006

For: RUBBER COMPOSITION FOR TIRE TREAD AND PNEUMATIC TIRE USING THE
SAME

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated December 30, 2009, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejection at issue: Claims 1-7 and 10-11 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 6,197,870 to Sakakibara.

Applicants respectfully traverse the rejection for at least the following reasons.

At page 3 of the Office Action dated December 30, 2009, the Examiner improperly asserts that Sakakibara discloses examples where the toluene tinting permeability is within the presently claimed range.

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Sakakibara discloses at col. 4, lines 34-43, col. 6, lines 9-13 and Tables 1-3, the specific tinting strength (%) of the carbon black. Specific tinting strength (Tint) is an index showing the size of the carbon black aggregate. See col. 4, lines 36-37 of Sakakibara. In contrast, toluene tinting permeability is represented by the percentage to pure toluene. See paragraph [0050] of the present specification. Clearly, these properties are different.

In this regard, Applicants note that the Examiner is relying on one property - Tint - to teach two different properties of the present invention - toluene tinting permeability (recited in Claim 1) and tinting strength (TINT, recited in dependent Claim 7). See page 3, lines 10-11 in the December 30, 2009 Office Action (referring to Examples 4-7 in connection with toluene tinting permeability) and page 4, lines 13-14 (referring to Examples 6 and 7 in connection with TINT), as well as the property Tint in Table 1 at col. 8 in Sakakibara. This is clearly improper.

As seen from the above, Sakakibara does not disclose or suggest the toluene tinting permeability of carbon black, as recited in the present claims. Thus, the Examiner has omitted an essential element necessary to establish a *prima facie* case of obviousness.

In addition, though acknowledging that Sakakibara does not disclose the hydrogen desorption ratio of the carbon black, the Examiner asserts at page 3 of the December 30, 2009 Office Action that the carbon black of Sakakibara would inherently meet the presently claimed limitation that the hydrogen desorption ratio is more than $0.260-6.25 \times 10^{-4} \times \text{CTAB}$ (wt%).

In response, Applicants submitted a Rule 132 Declaration by Mr. Yanagioka, demonstrating that the presently claimed hydrogen desorption ratio is not a property that would be inherently met by the carbon black of Sakakibara. See the Response filed March 30, 2010.

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The Examiner rejected the Rule 132 Declaration for the reason set forth at page 2 of the Advisory Action dated April 13, 2010. The Examiner's rejection is improper.

Sakakibara discloses the residence time, and therefore the carbon blacks shown in the Rule 132 Declaration by Mr. Yanagioka are prepared according to Examples 4-7 of Sakakibara with adjusting the residence time disclosed therein. Sakakibara, however, does not disclose the temperature, and thus, the temperature is assumed based on the CTAB surface area of the carbon black disclosed therein.

In this regard, the carbon blacks shown in the Mr. Yanagioka's declaration are synthesized by properly adjusting the factors in the furnace (i.e., the residence time and the temperature) which control the surface properties of the carbon black, and as such, the difference in the shape of the furnace does not have an effect on the properties of the resulting carbon blacks. As can be seen from the declaration, Examples 4-7 of Sakakibara do not satisfy either of (1) a hydrogen desorption ratio $> 0.260-6.25 \times 10^{-4} \times \text{CATB (wt\%)}$ or (2) a toluene tinting permeability of not less than 90%. Therefore, Sakakibara fails to disclose the carbon black used in the present invention.

In this regard, Appellants note that the basic properties of the carbon black (e.g., surface area, structure and the like) are mainly determined at the start of the reaction. The hydrogen desorption ratio, however, is dependent on the residence time in the reaction zone, i.e., the condition of the thermal history, and in particular, the residence time and the reaction temperature in the furnace.

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Finally, Appellants note that Sakakibara teaches that gripping performance can be improved by increasing Tint/CTAB, but fails to teach or suggest the means for lowering heat build-up of the robber. In addition, Sakakibara fails to teach or suggest the means for simultaneously accomplishing lower heat build-up and improved wear resistance. Therefore, one skilled in the art would not have expected the results obtained according to the present invention. See the discussion on page 3 in the March 30, 2010 Response in this regard.

For the foregoing reasons, it is respectfully submitted that claims 1-6 are patentable over the cited art.

Accordingly, Appellants respectfully request the reconsideration of the foregoing rejections.

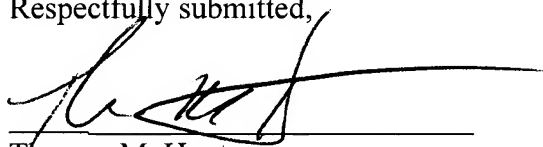
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Respectfully submitted,



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Date: June 30, 2010